

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
Attorney Docket No.: 14781US02**

In the Application of:

Jeyhan Karaoguz, *et al.*

Serial No.: 10/672,654

Filed September 26, 2003

For: MEDIA EXCHANGE NETWORK
HAVING MEDIA PROCESSING
SYSTEMS AND PERSONAL
COMPUTERS WITH COMMON USER
INTERFACES

Examiner: LUONG, ALAN H.

Group Art Unit: 2427

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REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
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Sir:

This Paper responds to the Examiner's Answer mailed February 1, 2011. The Applicants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1-7, 9-19, 21-31, and 33-40 of the present application for at least the reasons set forth in the Appeal Brief and this Reply Brief.

REMARKS

The Applicants note that the Examiner's Answer sets forth essentially the exact same arguments as the Final Office Action. *Compare* Examiner's Answer at pages 3-16 with June 30, 2010 Office Action at pages 4-16. The Applicants address these arguments in the Appeal Brief at pages 9-23. To the extent that the Examiner's Answer raises new issues, the Applicants will address below.

The Applicants reiterate that, in *Ex parte Hiyamazi*, the Board of Patent Appeals and Interferences reversed a rejection based on a combination of references, stating, in part:

Under 35 USC § 103, where the Examiner has relied upon the teachings of several references, the test is whether or not the references viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art. Note *In re Kaslow*, 707 F.2d 1366, 107 USPQ 1089 (Fed.Cir. 1983). **It is to be noted, however, that citing references which merely indicate the isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed references would have been obvious.** That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the claimed invention. Note *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed.Cir. 1986).

Ex parte Hiyamazi, 10 USPQ2d 1393, 1394 (B.P.A.I. 1988) (emphasis added).

"[T]he Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to **some concrete evidence in the record in support of these findings.**" *See In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (emphasis added).

I. The Proposed Combination Of Ellis In View Of Schoen And Parker Does Not Render Claims 1-7, 9-19, 21-31, and 33-40 Unpatentable

A. Claim 1

1. Constructing Media Channels

The Applicants note that the Examiner's Answer continues to rely on Ellis at column 8, lines 51-61, column 10, lines 34-44, column 10, lines 45-49, column 10, lines 50-60, column 10,

line 61 to column 11, line 6, column 11, lines 7-13, and column 11, lines 14-25 as allegedly disclosing “software resident in a first memory at the first home and a second memory at the second home, the software enabling a user at the first home to construct, at the first home, the one or more media channels from user selected and scheduled media content,” as recited in claim 1. *See Examiner’s Answer* at pages 16-19.

The Applicants analyze each of these cited portions in detail and demonstrate that the reasoning in the Examiner’s Answer is in error. *See Appeal Brief* at pages 11-18.

The Examiner’s Answer specifically points to Ellis at column 10, lines 34-44 as disclosing an “interactive television program guide software application **constructs** the Main Menu as the user interface” *See Examiner’s Answer* at page 17 (emphasis in original). The Applicants respectfully submit, however, that the Examiner’s Answer is in error. As explained in the Appeal Brief, this cited portion of Ellis does not even mention a user “constructing” anything. *See Appeal Brief* at pages 13-14. Further, contrary to the assertion in the Examiner’s Answer, there is nothing in this cited portion of Ellis that even remotely suggests constructing a Main Menu, in general, or as a user interface. *See id.* Instead, the cited portion merely notes that a “menu screen 156 ... may be displayed” *See Ellis* at column 10, lines 34-44.

Contrary to the assertion in the Examiner’s Answer, Ellis at column 10, lines 34-44 does not even mention a user “constructing” anything, let alone one or more “media channels.” This portion of Ellis is also silent with respect to the user selecting media content or scheduling media content for use in constructing such “media channels.”

The Examiner’s Answer also specifically points to Ellis at column 10, lines 45-49 as allegedly disclosing “an interactive television program guide software application **constructs** the Main Menu as the user interface” *See Examiner’s Answer* at pages 17-18 (emphasis in original). The Applicants explain why this assertion is clearly in error. *See Appeal Brief* at page 14. Contrary to the assertion in the Examiner’s Answer, Ellis at column 10, lines 45-49 is silent with regard to a user “constructing” anything, let alone one or more “media channels.” This portion of Ellis is also silent with respect to the user selecting media content or scheduling media content for use in constructing such “media channels.”

The Examiner's Answer also specifically points to Ellis at column 10, lines 50-60 as allegedly disclosing "an interactive television program guide software application **constructs** the Main Menu as the user interface" See Examiner's Answer at page 18 (emphasis in original). The Applicants explain why this assertion is in clear error. See Appeal Brief at pages 14-15. Contrary to the assertion in the Office Action, Ellis at column 10, lines 50-60 fails to disclose a user "constructing" anything, let alone constructing one or more "media channels." The cited portion of Ellis at column 10, lines 50-60, also does not disclose a user selecting media content or scheduling media content for use in constructing such "media channels."

The Examiner's Answer also specifically points to Ellis at column 10, line 61 to column 11, line 6 as allegedly disclosing an "interactive television program guide software application **constructs** the Main Menu as the user interface" See Examiner's Answer at page 18 (emphasis in original). The Applicants explain why this assertion is clearly in error. See Appeal Brief at pages 15-16. Contrary to the assertion in the Office Action, Ellis at column 10, line 61 to column 11, line 6 fails to disclose a user "constructing" anything, let alone constructing one or more "media channels." The portion of Ellis at column 10, line 61 to column 11, line 6 also does not describe, teach, or suggest a user selecting media content or scheduling media content for use in constructing such "media channels."

The Examiner's Answer also specifically points to Ellis at column 11, lines 7-13 as allegedly disclosing an "interactive television program guide software application **constructs** the Main Menu as the user interface" See Examiner's Answer at page 18 (emphasis in original). The Applicants explain why this assertion is also in clear error. See Appeal Brief at page 16. Notably, in direct contrast to the assertion in the Office Action, Ellis at column 11, lines 7-13 fails to make any mention of a user "constructing" anything, let alone constructing one or more "media channels." The portion of Ellis at column 11, lines 7-13 does not describe, teach, or suggest a user selecting media content or scheduling media content for use in constructing such "media channels."

The Examiner's Answer also specifically points to Ellis at column 11, lines 14-25 as allegedly disclosing an "interactive television program guide software application **constructs** the Main Menu as the user interface" See Examiner's Answer at pages 18-19 (emphasis in

original). The Applicants explain why this assertion is in clear error. *See* Appeal Brief at page 17. Contrary to the assertion in the Examiner's Answer, Ellis at column 11, lines 14-25 fails make any mention of a user "constructing" anything, let alone constructing one or more "media channels." This passage from Elli also does not describe, teach, or suggest a user selecting media content or scheduling media content for use in constructing such "media channels."

The Applicants have reviewed all portions of Ellis relied on by the Examiner's Answer as allegedly disclosing "software resident in a first memory at the first home and a second memory at the second home, the software enabling a user at the first home to construct, at the first home, the one or more media channels from user selected and scheduled media content," as recited in claim 1, for example, and have demonstrated that, contrary to the assertions in the Office Action, these portions of Ellis do not describe, teach, or suggest all of the limitations of claim 1. Accordingly, for at least these reasons, the Office Action has committed clear error, and failed to establish a *prima facie* case of obviousness with respect to claim 1 and the claims that depend therefrom.

2. Closed And Secure Communication

Claim 1 also recites, in part, "the software also enabling closed and secure communication of the one or more media channels to members of a user group, in a peer to peer manner, from the first home to the second home." The Applicants explain in detail that the Office Action, and therefore the Examiner's Answer, fails to show where any of the cited references describe, teach, or suggest these limitations. *See* Appeal Brief at pages 18-20.

The Examiner's Answer asserts that "Ellis discloses Personal TV Channel is constructed by interactive Program Guide, Schoen melodies [sic] the acknowledged deficiency of Ellis "the software also enabling closed and secure communication of the one or more media channels to members of a user group, in a peer to peer manner, from the first home to the second home."" *See* Examiner's Answer at pages 20-21. As explained above, however, the Examiner's Answer fails to demonstrate that Ellis describes, teaches, or suggests constructing anything, let alone media channels. Further, the Applicants explain that the Examiner's Answer errs in its reasoning and analysis with respect to Schoen. *See* Appeal Brief at pages 18-20.

Additionally, the Examiner's Answer states the following:

Examiner do [sic] not mention the phrase “peer to peer” in the Prior Art reference to teach “peer to peer” communication as claimed because Prior Art discloses the **architecture** is same meaning [sic] of the phrase “**peer to peer**”. It is well known in the art; by definition; communication between 2 computers with the same communication protocol named peer to peer (see **Microsoft Computer Dictionary, page 397**). In this case, Fig. 1 of Schoen illustrates the instant messaging system 10; includes an **instant messaging server** 12 where is in [sic] operative communication with a plurality of instant messaging devices as PDA, Set-top box, computers etc... as **peer-to-peer architecture**. For purposes of discussion, one of the instant messaging device (one peer) will be referred to as an instant messaging originator 14 which will be described as initiating an instant message while another instant messaging device 16 (another peer) will be referred to as instant message recipient, although it will be recognized that either device may operate to send or received instant messages. Thus, **Schoen explicitly teaches “peer to peer” communication in the cited portions**. In this case, Examiner applies the Rationale guideline A.

See Examiner’s Answer at pages 21-22 (emphasis added).

The Applicants note that the Examiner has not provided the Applicants with a copy of “Microsoft Computer Dictionary, page 397.” However, the Applicants have attached a copy of Microsoft Press Computer Dictionary, Third Edition, page 359. In this edition, “peer to peer” is not found at page 397.

As discussed previously, Schoen wholly fails to mention the phrase “peer-to-peer,” let alone a “peer-to-peer architecture.” Therefore, the assertion in the Examiner’s Answer that “Schoen **explicitly** teaches ‘peer to peer’ communication in the cited portions” is in clear error.

Next, the Microsoft Press Computer Dictionary defines “peer-to-peer architecture” as follows:

A network of two or more computer that use the same program or type of program to communicate and share data. Each computer, or *peer*, is considered equal in terms of responsibilities and each acts as a server to the others in the network. Unlike a client/server architecture, a dedicated file server is not required. However, network performance is generally not as good as under client/server, especially under heavy loads. *Also called* peer-to-peer network. *See also* peer, peer-to-peer communications, server. *Compare* client/server architecture.

See Microsoft Press Computer Dictionary, Third Edition, page 359 (emphasis added) (attached).

As noted above, the Examiner's Answer asserts that Schoen discloses a "peer-to-peer architecture," but then states that Schoen teaches an "instant messaging server" that communicates with the "instant messaging device(s)." As such, the Examiner's Answer contradicts the definition of peer-to-peer architecture that is set forth in the Microsoft Press Computer Dictionary. That is, as shown above, the actual definition of "peer-to-peer architecture" states that each computer (i.e., peer) acts as a server, but, unlike a client/server architecture, a dedicated file server is not required.

Moreover, the Examiner's Answer fails to provide any "concrete evidence" that each of the "message originator 14" and "messaging device 16" (the "peers," according to the Examiner's Answer) in fact "acts as a server to the others in the network," as required of a "peer-to-peer architecture." See Microsoft Press Computer Dictionary, Third Edition, page 359.

For at least these reasons, the Examiner's Answer errs when it assumes that Schoen discloses a "peer-to-peer" architecture.

B. Claim 14

For at least the reasons discussed above with respect to claim 1, the Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness with respect to claim 14 and the claims that depend therefrom.

C. Claim 25

For at least the reasons discussed above with respect to claim 1, the Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness with respect to claim 25 and the claims that depend therefrom.

II. Obviousness Guidelines

The Applicants previously requested the following:

If the current rejections are maintained, the Applicants respectfully request that the Examiner's Answer: 1) **identify the specific Rationale** (i.e., by specifically indicating one of **A through G** noted above) in the Guidelines that the Examiner is using to support the obviousness rejections so that the Applicants may more clearly address the Examiner's concerns, and 2) **state on the record the required** factual findings to support the Rationale that

the Examiner has chosen. Failure to specifically identify the specific rationale and state the required factual findings will seemingly be a tacit admission that the Examiner is unable to satisfy the **required** factual findings.

See Appeal Brief at pages 21-23 (emphasis in original).

In response, the Examiner's Answer points to "Rationale guideline A" (Combining prior art elements according to known method to yield predictable results). See Examiner's Answer at page 22. ("thus, Schoen explicitly teaches "peer to peer" communication in the cited portions. In this case, **Examiner applies the Rationale guideline A**").

However, PTO Guidelines for Rationale A state the following:

To reject a claim based on this rationale, Office personnel must resolve the *Graham* factual inquiries. Office personnel must then articulate the following:

- (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference;
- (2) a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately;
- (3) a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable; ...

See Federal Register, Vol. 72, No. 195.

Initially, with respect to the required *Graham* factual inquiries the Examiner's Answer wholly fails to "resolve the level of ordinary skill in the pertinent art." Instead, the Examiner's Answer merely lists isolated elements from the references and summarily notes "one of ordinary skill in the art" without attempting to **resolve the level** of ordinary skill in the art. See Examiner's Answer at, for example, page 8.

Next, with respect to required Factual Finding (1), the Examiner's Answer fails to demonstrate that the "prior art included each element claimed, although not necessarily in a single prior art reference," as explained above.

Next, with respect to required Factual Finding (2), the Examiner's Answer does not attempt to demonstrate, through "concrete evidence," that one "could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately." Instead, the Examiner's Answer merely cites references that allegedly "indicate the isolated elements and/or features recited in the claims." See *Ex parte Hyamazi*, 10 USPQ2d 1393, 1394.

Finally, with respect to required Factual Finding (3), the Examiner's Answer does not attempt to demonstrate, through "concrete evidence," that the "results of the combination were predictable." The Examiner's Answer does not even mention the term "predictable" in combining the references, despite the Examiner's Answer specifically relying on Rationale A to support the proposed combination. See Examiner's Answer at page 22, for example.

Thus, for at least these additional reasons, the Applicants respectfully submit that the Examiner's Answer fails to establish a *prima facie* case of unpatentability with respect to the pending claims.

III. CONCLUSION

For at least the reasons discussed in the Appeal Brief and above, the Applicants respectfully request reconsideration of the claim rejections. The Board is respectfully requested to reverse the rejections of pending claims 1-7, 9-19, 21-31, and 33-40.

The Commissioner is authorized to charge any necessary fees, or credit any overpayment to Deposit Account 13-0017.

Respectfully submitted,

Dated: March 4, 2011

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PD-CD drive \pɪd-ˈsiːd-ˈdraɪv/ *n.* Short for phase change rewritable disc-compact disc **drive**. A storage device that combines a CD-ROM drive and a phase change rewritable disc (PD) drive, which can store up to 650 megabytes of data on cartridges of rewritable optical discs. *See also* phase-change recording.

PDD \pɪd-ˈdiː/ *n.* Acronym for **Portable Digital Document**. A graphics file created from a document by QuickDraw GX under Mac OS. PDDs are stored in a form that is independent of printer resolution: they print at the highest resolution available on the printer used; and they can contain the original fonts used in the document. Therefore, a PDD can be printed by a computer other than the one on which it was created.

.pdf \ˈdɒt-pi-dɪ-ˈf/ *n.* The file extension that identifies documents encoded in the Portable Document Format developed by Adobe Systems. In order to display or print a .pdf file, the user should obtain the freeware Adobe Acrobat Reader. *See also* Acrobat, Portable Document Format.

PDL \pɪd-ˈl/ *n.* *See* page-description language.

PDM \pɪd-ˈm/ *n.* *See* pulse duration modulation.

PDO \pɪd-ˈo/ *n.* *See* Portable Distributed Objects.

PD8 \pɪd-ˈs/ *n.* 1. Acronym for **Processor Direct Slot**. An expansion slot in Macintosh computers that is connected directly to the CPU signals. There are several kinds of PD8 slots with different numbers of pins and different sets of signals, depending on which CPU is used in a particular computer. 2. Acronym for **Parallel Data Structure**. A hidden file, located in the root directory of a disk that is shared under AppleShare, that contains access privilege information for folders.

.pe \ˈdɒt-pi-ˈe/ *n.* On the Internet, the major geographic domain specifying that an address is located in Peru.

.pe.ca \ˈdɒt-pi-ˈe-ˈdɒt-si-ˈe/ *n.* On the Internet, the major geographic domain specifying that an address is located on Prince Edward Island, Canada.

peek \piːk/ *vb.* 1. To read a byte from an absolute memory location. Peek commands are often found in programming languages such as Basic that do not normally allow access to specific memory locations. 2. To look at the next character in a buffer associated with an input device without actually removing the character from the buffer.

peer \piːr/ *n.* Any of the devices on a layered communications network that operate on the same protocol level. *See also* network architecture.

peer-to-peer architecture \piːr-tə-ˈpiːr ˈɑːr-kɪ-tek-tʃər/ *n.* A network of two or more computers that use the same program or type of program to communicate and share data. Each computer, or *peer*, is considered equal in terms of responsibilities and each acts as a server to the others in the network. Unlike a client-server architecture, a dedicated file server is not required. However, network performance is generally not as good as under client-server, especially under heavy loads. *Also called* peer-to-peer network. *See also* peer, peer-to-peer communications, server. *Compare* client-server architecture.

peer-to-peer communications \piːr-tə-ˈpiːr kɔm-yʊn-ɪ-kə-ˈʃən/ *n.* Interaction between devices that operate on the same communications level on a network based on a layered architecture. *See also* network architecture.

peer-to-peer network \piːr-tə-ˈpiːr net-ˈwɜːk/ *n.* *See* peer-to-peer architecture.

pel \piːl/ *n.* Short for **picture element**. *See* pixel.

PEM \piː-ˈe-m/ *n.* *See* Privacy-Enhanced Mail.

pen \piːn/ *n.* *See* fountain pen, stylus.

pen-based computing \piːn-ˈbeɪd kɔm-pyʊt-ɪŋ/ *n.* The process of entering handwritten symbols into a computer via a stylus and pressure-sensitive pad. *See also* pen computer.

pen computer \piːn kɔm-pyʊt-ɪŋ/ *n.* Any of a class of computers whose primary input device is a pen (stylus) instead of a keyboard. A pen computer is usually a smaller, handheld device and has a flat semiconductor-based display such as an LCD display. It requires either a special operating system designed to work with the pen input device or a proprietary operating system designed to work with a specific-purpose device. The pen computer is the primary model for an emerging class of computers known as personal digital assistants (PDAs). *See also* clipboard computer, PC Card, PDA.

pen plotter \piːn-ˈplɒt-ɪŋ/ *n.* A traditional graphics plotter that uses pens to draw on paper. Pen plotters use one or more colored pens, either fiber-tipped pens or, for highest-quality output, drafting pens. *See also* plotter. *Compare* electrostatic plotter.